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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY	CKET NO.	CONFIRMATION NO.
09/646,825	09/22/2000	Satoshi Mori	55022		1169

7590 11/08/2002

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EXAMINER
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SCHMIDT, MARY M

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 11/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/646,825

Applicant(s)

MORI ET AL.

Examiner

Mary M. Schmidt

Art Unit

1635

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 October 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 20-29.

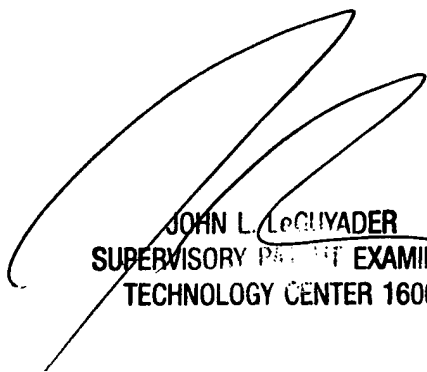
Claim(s) withdrawn from consideration: 1-16.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

, Continuation of 2. NOTE: Applicant states on page 4 of the response filed 10/1/02 that "[a]s an initial matter, Applicant respectfully request that the finality of the rejection be withdrawn... it is submitted that the final rejection was premature in that the claims have only been examined on the merits once. By way of history, a first office action issued by the PTO on November 23, 2001, (paper no. 8), indicated that claims 17-21 were merely objected to under 37 CFR 1.75/c as being in improper multiple dependent form.... The Office Action expressly indicated that these claims were therefore not examined on the merits. Applicants subsequently filed an Amendment on February 25, 2002, (paper no. 9), to present the claims in a format suitable for examination. In particular, claims 17-21 were cancelled and rewritten as new claims 22-29. these claims have now been substantively examined only once, however, the status of the rejection is indicated as being final. It is submitted that the final status of the rejection is clearly improper." In response, the finality of the previous office action may not be withdrawn since the claims 17-21 as originally filed were not proper and thus were treated according to MPEP 608.01(n) guidelines.

Although applicant's response canceling claims 1-16 and 22-29 would obviate the rejection of these claims, the proposed new claims 30-45 would require new consideration on the merits and does not further place the case in condition for allowance because new claims 31, 35 and 43 add new limitations: "wherein the gene is derived from yeast" (claim 31) and "wherein the base sequence located upstream of the gene's initiation codon is altered to a sequence for effective translation of mRNA known as Kozak sequence" (claims 35 and 43). These new limitations require a new search. As indicated in the previous office action, SEQ ID NO:1 was found to be free of the prior art, but applicant is not considered in possession of, nor enabled for, the breadth of nucleic acids claimed in new claims 30-37 and 39-44 for the same reasons of record set forth in the previous office action mailed 5/22/02, under 35 U.S.C. 112, first paragraph. The proposed new claim 30 for instance claims any nucleic acid having a modified base sequence of a gene for transforming a plant, wherein the sequence is modified by features (A) and (B) without altering the amino acid sequence, for eliminating the sequences relating to poly(A) addition. Applicant's arguments have been considered but have not overcome the rejections under 35 U.S.C. 112, first paragraph. The claimed nucleic acids are not "isolated and purified" and since the breadth of "gene" is not defined (ie. does it include non-coding regions?), and since the specific nexus between the claimed nucleic acids having a modified base sequence of a gene, without altering the amino acid sequence, has not been further defined (ie. the claims don't specify that the amino acid sequence this is not altered comes from the coding region of the claimed nucleic acids). Therefore, the broad claims at least would still require further consideration on the merits and the claims are not entered accordingly..

Continuation of 5. does NOT place the application in condition for allowance because: the request for reconsideration proposes cancelling claims 1-16 and 22-29 and adding new claims 30-45. The new claims require further consideration on the merits and do not place the application in condition for allowance for the reasons set forth in the section 2, note, above.



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